

### **REMARKS**

Applicants hereby file this Response pursuant to 37 C.F.R. § 1.111(a) in response to the office action ("Office Action") mailed on November 27, 2007. Claims 15, 21 and 55 have been objected to as containing informalities. Claims 15, 21 and 55 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,464,134 to Page ("Page") in view of U.S. Patent No. 5,903,818 to Talati *et al.* ("Talati"). Claims 17, 56-58, 64 and 65 have been rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over Page in view of Official Notice. Claims 15, 17, 21, 55-58, 64, 65 and 68-76 are pending.

#### **I. The Objections Are Moot**

The objections to claims 15, 21 and 55 are moot in view of the amendments to these claims submitted herewith.

#### **II. The Examiner Is Invited To View A Demonstration**

The Examiner is invited to view a demonstration of an embodiment of the present invention at the following web site:

[https://www.usaa.com/inet/ent\\_utils/McStaticPages?key=bank\\_deposit&bpjs=false](https://www.usaa.com/inet/ent_utils/McStaticPages?key=bank_deposit&bpjs=false)

After entering the above URL into a browser, the demonstration is available by clicking on the gold star-shaped "View Demo" button. The demonstration and associated product were developed for USAA by the assignee of the present application.

#### **III. The Cited References Fail To Disclose Depositing An Amount Of A Conventional Check Without Physical Receipt Of The Conventional Check**

Claim 15 recites "depositing the discrete value of the conventional check ... without physical receipt of the conventional check." Claim 21 recites "depositing the discrete value of the check without physical receipt of the conventional check." Claim 55 recites "depositing the discrete value of each conventional check ... without physical receipt of each conventional check." The cited references, alone or in combination, fail to disclose these features.

The Office concedes that Page fails to disclose these limitations. *See* Office Action, page 4 ("Page fails to disclose ... processing the discrete value of the conventional check for deposit by

the automatic banking system without physical receipt of the conventional check by the automated banking system.”). The Office instead relies on Talati as disclosing these limitations. *See id.* Applicants respectfully assert that reliance on Talati is misplaced.

Talati is directed to a system that completely avoids conventional checks. Instead, Talati is directed to a providing validated electronic transactions. *See* Talati, Abstract. Talati’s entire technique is accomplished electronically without need for any conventional checks. *See* Talati, column 2, lines 48-49, column 6, lines 53-55, column 8, lines 15-16 (“*All* these processing steps may be performed in electronic transactions.”) (emphasis added). Talati never even considers conventional physical checks, let alone depositing a value of a conventional check. Accordingly, Talati fails to disclose “depositing the discrete value of the conventional check,” “depositing the discrete value of the check,” or “depositing the discrete value of each conventional check” as claimed.

The Office asserts that Talati discloses “processing the discrete value of the conventional check for deposit...” *See* Office Action, page 4. Applicants respectfully assert that this statement is false. Specifically, Talati never even considers conventional checks, let alone depositing a value of a conventional check. Talati is exclusively concerned with transactions that are entirely electronic. *See* Talati, column 2, lines 48-49, column 6, lines 53-55, column 8, lines 15-16. Indeed, Talati is *incapable* of handling conventional physical checks, because Talati explains that *all* of Talati’s technique may be accomplished electronically. *See* Talati, column 8, lines 15-16. Thus, Talati does not and *cannot* process a value of a conventional check, as claimed. Accordingly, Talati fails to disclose the claim limitations at issue.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: “[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.” Because the cited references fail to disclose “depositing the discrete value of the conventional check ... without physical receipt of the conventional check,” “depositing the discrete value of the check without physical receipt of the conventional check” or “depositing the discrete value of each conventional check ... without physical receipt of each conventional

check,” the rejection of the independent claims, and all claims dependent thereon, is improper and must be withdrawn.

**IV. The Combination Of Page And Talati Would (1) Change The Principle Of Operation Of Both References And (2) Have No Reasonable Expectation Of Success**

“If the proposed modification or combination of the prior art would change the principle of operation if the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP § 2143.01(VI). Further, a “reasonable expectation of success is required.” *See* MPEP § 2143.02. Here, the principle of operation of both references would be entirely destroyed by combining them. Moreover, there is no reasonable expectation of successfully combining Page with Talati.

Page is directed to a technique for verifying the authenticity of a conventional physical check. *See* Page, Abstract. ***Page requires physical examination of the conventional check at least twice.*** *Id.* Specifically, when the check is initially issued by a payor, an “issuing terminal” scans the face of the conventional check for particular data. *See* Page, column 6, lines 52-59. Upon redeeming (*i.e.*, cashing) the check, a “cashing terminal” again reads particular data that appears on the face of the check. *See* Page, column 8, lines 15-26. The data read at the issuing terminal are then compared with the data read at the cashing terminal, and the check is rejected if the data do not match. *See* Page, Abstract. Thus, Page ***requires*** that a conventional physical check be present throughout Page’s technique, particularly at the beginning and at the end. *Id.*

As discussed above in Section III, Talati considers - exclusively - electronic transactions. *See* Talati, Abstract. Talati’s entire technique is accomplished electronically, without need for a conventional physical check. *See* Talati, column 2, lines 48-49, column 6, lines 53-55, column 8, lines 15-16 (“*All these processing steps may be performed in electronic transactions.*”) (emphasis added). Thus, Talati never even considers conventional physical checks.

A combination of Page with Talati would destroy the principle of operation of Page and be inoperable. For example, Page’s technique is incompatible with Talati’s technique, because a combination of Page with Talati would prevent Page from physically examining conventional

checks at the beginning and the end of Page's process. More particularly, if one were to replace Page's conventional checks with electronic checks at any point in Page's process, there would be no conventional check to scan, as Page unequivocally requires. *Cf.* Page, Abstract, column 6, lines 52-59 and column 8, lines 15-26. Accordingly, a combination of Page with Talati would destroy the fundamental principle of operation of Page and have no reasonable expectation of success, because it would prevent Page's required scanning of conventional checks.

Likewise, combining Page with Talati would destroy the fundamental principle of operation of Talati's technique. Specifically, Talati requires that Talati's technique be performed exclusively in the electronic domain, without any conventional checks. *See* Talati, column 8, lines 15-16. Combining Talati with Page to introduce conventional checks into Talati's technique would make exclusively electronic transactions, as taught by Talati, impossible. Moreover, a combination of Talati with Page would be inoperable, as neither reference discloses how to conduct exclusively electronic transactions once conventional checks are introduced. Thus, a combination of Talati with Page would be inoperable and destroy the fundamental principle of operation of Talati.

Because combining Page with Talati would destroy the fundamental principle of operation of both references, and because such a combination could not be made operational, such a combination cannot properly be relied upon for a rejection under 35 U.S.C. 103. *See* MPEP §§ 2143.01(VI) and 2143.01. Accordingly, the rejection is improper and must be withdrawn.

**V. The Combination Of Page And Talati Would Render Page Unsatisfactory For Its Intended Purpose**

"The proposed modification cannot render the prior art unsatisfactory for its intended purpose." MPEP § 2143.01(V). Here, the proposed combination of Page with Talati would render Page unsatisfactory for its intended purpose.

As discussed above in Sections II and III, Page is directed to a technique for verifying the authenticity of a conventional check. *See* Page, Title. More particularly, Page's technique for verifying conventional checks requires scanning data on the face of such checks.

A system and method for *verifying the authenticity of a bank check* and authorizing payment of the bank check at any of a plurality of banks or check cashing agencies, wherein a payor or issuer of the check integrates account data normally pre-printed on the face of the check with individualized payee data, at least including payee identification and a value of the check, so as to define a first set of data, which is communicated to a processing center for temporary storage and eventual comparison. Upon presentation of the check for deposit or cashing, the bank or check cashing agency will establish a second set of data based on the *pre-printed account data and the individualized payee data that appears on the face of the check presented*.

Page, Abstract (emphasis added). Combining Page with Talati by replacing Page's conventional checks with electronic checks, as proposed by the Office, would make it impossible for Page to scan and compare "*pre-printed account data and the individualized payee data that appears on the face of the check presented*" as taught by Page. See Page, Abstract. Accordingly, the Office's proposed combination would not be able to verify the authenticity of a bank check, which is the stated purpose of Page's invention. See Page, Title and Abstract.

Because the proposed combination of Page with Talati would render Page unsatisfactory for its intended purpose, the combination cannot properly be relied upon for a rejection under 35 U.S.C. 103. See MPEP § 2143.02. Accordingly, the rejection is improper and must be withdrawn.

#### **VI. The Rejections Of Claims 17, 56-58, 64 and 65 Are Improper**

The arguments presented with respect to claims 17, 56-58, 64 and 65 in Applicants' response of June 15, 2007 are hereby incorporated by reference and re-asserted. For example, with respect to claim 65, the cited section of Page (col. 8, line 64 - col. 9, line 19) discloses actions taken by the *issuer* of the check. If the actions cited by the Office were taken by the *issuer* of the check, the payee would not later be able to present the check to the bank or check cashing agency for deposit or cashing. Further, Page does not disclose each and every limitation of claims 15, 21 and 55, from which these dependent claims depend. Accordingly, Page does not disclose each and every limitation of these claims, either. Applicants therefore respectfully submit that these rejections should be withdrawn for failure to support a *prima facie* case of obviousness.

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

In the event that the U.S. Patent and Trademark Office requires a fees to enter this Reply or to maintain the present application pending, please charge or credit such variance to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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Dated: February 20, 2008

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